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| 10/014,191  | 11/13/2001  | Christoph Dobrusskin | PHN 16,257A         | 4074             |
| 24737 7590 04/30/2009<br>PHILIPS INTELLECTUAL PROPERTY & STANDARDS<br>P.O. BOX 3001<br>BRIARCLIFF MANOR, NY 10510 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| HYLINSKI, STEVEN J  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 3714  |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/014,191

**Applicant(s)**

DOBRUSSKIN ET AL.

**Examiner**

STEVEN J. HYLINSKI

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6, 12 and 16-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6, 12, 16-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

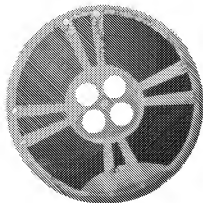
1. Examiner disagrees with Applicants' argument over the identity of Icon **311** as not being "representative of the item". As stated, Harris says that icons **311** are "icons corresponding to available commands". The headings above the icons are "VCR ADDRESS" and "REWINDING VCR TAPE", and an arrow **312** is selecting one of the icons. Here are two of the icons **311** as shown in Fig. 20, enlarged to show detail.



Below are two images that are used as evidence that the above images, (especially considering their association with the VCR in Fig. 20 of Harris), can obviously be interpreted as film reels, considering Harris' context of these icons being used to command a VCR device.



Film reel clip art #1, sourced from [http://www.free-graphics.com/clipart/Entertainment/film\\_reel.shtml](http://www.free-graphics.com/clipart/Entertainment/film_reel.shtml)  
and



Film reel clip art #2, sourced from <http://www.clker.com/clipart-video-film-reel.html> and identified on this page as "Video Film Reel"

In light of the above evidentiary images showing how **311** would be recognizable by one of skill in the art as obviously being film reels, and also considering that Fig. 20 shows an exemplary command interface identified as REWINDING VCR TAPE, any artisan of skill in the art could obviously identify the icons **311** with the VCR functions. By association, the icons **311** are representative of the device with which they are functionally tied.

Even if, for the sake of argument, the identity of the icons **311** as being film reels that would identify the VCR, is not agreed upon, the visual appearance of an icon can be rejected under MPEP 2114.04 as an aesthetic design change, and also as a change in shape. Changing the appearance of an icon can even further be rejected as a design choice consideration because applicant has not disclosed that the appearance of the icon provides an advantage, solves a stated problem, or is used for a particular purpose. It would have been well within the realm of one of skill in the art to change the appearance of an icon, and doing so would cause no unexpected results.

2. New claims 24 and 29 merely recite a decorative change in shape of an icon, with no unexpected result cited as a consequence of the change in shape. Beyond the fact that any artisan of skill in the art would recognize that changing an icon would not cause an unexpected difference in a computerized graphical interface (the rationale being that altering a known device in a known way producing a known result is not patentable), altering the visual appearance of a graphical icon can be rejected as both an aesthetic design change, and as a change in shape, both rejectable under MPEP Section 2144.04, subsections I. and IV., as failing to be patentable distinctions over the prior art. Accordingly, claims 24 and 29 are rejected as failing to patentably distinguish the instant invention from that of the prior art.

### **I. AESTHETIC DESIGN CHANGES**

*In re Seid* , 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.). But see \*\* *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965) (Claims were directed to fried potato chips with a specified moisture and fat content, whereas the prior art was directed to french fries having a higher moisture content. While recognizing that in some cases the particular shape of a product is of no patentable significance, the Board held in this case the shape (chips) is important because it results in a product which is distinct from the reference product (french fries).).

### **IV. CHANGES IN SIZE, SHAPE, OR SEQUENCE OF ADDING INGREDIENTS**

#### **B. Changes in Shape**

*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 4-6, 12, and 16-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,331,972 to Harris et al. (Harris), in view of US 5715416 to Baker.**

**Re Claims 4, 12, 16, 23, 25-26, 28, and 30,**

Harris discloses a multimedia method and computer program for use with a screen-based host system (Col. 6 Lines 11-54, Harris discloses a peer-to-peer system, which by definition means that each node, which can be a PDA, cell phone, PC, etc, and hence-screen based, functions as both a client and server or host at the same time, without the need for a central server.) provided with information processing and I/O facilities (Fig. 2 shows exemplary hardware included in a peer device, which includes processor **40** and optional I/O devices **46**), and for interacting with an item, the method comprising: receiving identity information from the item at the host (Fig. 6, block **82** shows that the two peer to peer devices evaluate their needs vs. capabilities. Figs. 8 and 9 give examples of needs and capabilities that each device can have, which include information that identify the device.) in response to proximity conditions between the host and the item (Col. 6 Lines 31-35), presenting to a user an icon that is representative of the item (as discussed in the argument section above, the icons **311** that are functionally tied to the VCR of Fig. 20, would obviously be recognizable by one of skill in the art, as representing video reels. Video reels can reasonably be interpreted as representing a video cassette recorder machine due to their common theme. Even if, for the sake of argument, the icons **311** were not recognizable as video reels that could be associated with the VCR device, which Examiner is not conceding, MPEP § 2144.04

states that aesthetic and change-in-shape differences over the prior art fail to render an invention patentable. Furthermore, the visual appearance of a graphical user interface icon can be rejected as a design choice consideration, as discussed above.) and associated service field at the host in response to the identity information (Col. 12 Lines 62-67 and Col. 13 Lines 1-5, if the two devices are in range of each other and their capabilities and needs are compatible, a program is transferred from one device to the other and a user interface is automatically loaded to allow the user of one device to access the other device. Fig. 20 shows an example of a user's device **300** that has had a program loaded on it to control another device. The graphical user interface shown on display **309** is clearly a service field.), and transmitting information based on the interaction from the host to the item, for storage at the item (Figs. 8-9 show examples of data items that one device needs to transfer from the other device. Each device has memory **42** as shown in Fig. 2, which must at least temporarily store data received from the other device), selecting an icon that is representative of the item (Fig. 20, arrow **312** indicates the user's selection of one of the icons **311**. See the rejection of claim 4 above, in which it is discussed that the icons can be interpreted as video reels that one of skill in the art would associate with the VCR device, and alternatively, that changes in shape and aesthetic changes do not render an invention patentable over the prior art per MPEP 2144.04) and application program based on the identity information, the application program including one of an information processing program and an entertainment program (Col. 12 Lines 62-67 and Col. 13 Lines 1-5, if the two devices are in range of each other and their capabilities and needs are compatible, a program is



transferred from one device to the other and a user interface is automatically loaded to allow the user of one device to access the other device, hence the program is an information processing program), executing the application program at the host system (Fig. 10 112)

However, Harris lacks the icons varying location within a service field of the application based on actions of a user to facilitate interaction with the application program, the icons being user-definable, and being animated.

Baker is an analogous prior art reference in the art of graphical user interfaces , that proves it is very old and well-known in the art to allow users of a graphical user interface to create their own user-definable icons for use in the graphical user interface, (See Columns 3 and 9) and also that icons can be animated with animations unique to the icon (Column 9 Lines 38-67). Animating icons according to the method of Baker, also meets the limitation of the icon varying location based on the actions of the user, to facilitate the user's interaction with the application program (Col. 9 Lines 34-65 describes how icons have icon-specific animations. Baker further provides evidence that the shape of the icon, such as that used by Harris as discussed above, is a design choice consideration in the art. Baker states that it is known for each icon in an operating system, to be associated with a structure that contains information that associates operating system file objects with the icon, and also pictorial information with the icon. Col. 22 shows that it is known for the data structure describing the icon, to contain information labeled "icon.image", which specifies what image is associated with the icon.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art, that incorporating Baker's old and well-known teaching of user definable and animated icons being used to improve a graphical user interface having icons associated with commands, into Harris' compatible and ready-for-improvement invention, would cause results predictable to one of skill in the art, devoid of any new or unexpected consequences.

**Re Claim 5,**

Harris discloses enabling the user to activate information processing operations at the host related to the associated service field (Col. 13 Lines 1-8, the user at one peer device can control the other peer device using the user interface that has been loaded).

**Re Claim 6,**

Harris discloses transmitting host-generated results related to the associated service field during such proximity conditions to the item (Fig. 20 shows the exemplary embodiment of host 300 being able to send commands to one or more VCR's. These commands, input by the user using the interface on the PDA, constitute host-generated results.)

**Re Claims 22, 24 and 29,**

Examiner discusses above how one of skill in the art would recognize the icons 311 associated with VCR commands, as video reels intended to establish their functional relationship to the VCR device. Even if this fact is argued, MPEP 2144.04 states that aesthetic design changes and changes in shape fail to render an invention

patentable over the prior art. Changing the visual identity of an icon constitutes both an aesthetic design change and a change in shape. Furthermore, in view of Baker's teaching that it is old and well-known in the art that the images associated with icons in graphical user interfaces can be readily changed, it would have been further obvious to one of ordinary skill in the art, at the time the invention was made, that changing the visual identity of an icon in a graphical user interface, would produce merely predictable results.

**Re Claims 17 and 31,**

In Col. 12 Lines 62-67 and Col. 13 Lines 1-5, Harris discloses that one of the peer devices loads an application program from the other, and then presents the user's device with a user interface based on the program. Harris shows providing an iconized representation of an item at a host in response to the identity information in Fig. 20. In this figure, PDA **300**, which is both a host and a client since it is used in a P2P network, provides iconized representations of a VCR with host-commandable features of the VCR represented by icons **311**. In order to provide icons of the VCR to the host, the PDA, the PDA must know what the identity of the VCR is, since Harris' system can be used with many different types of devices. Col. 6 Lines 27-37 discloses, and Fig. 6 shows the P2P devices exchanging information regarding their needs and capabilities "for forming a communication network". Fig. 21 shows addresses being exchanged between two items. Harris discloses in Col. 18 Lines 40-67 that "Controller **300** includes [...] display **309** showing icons **311** corresponding to available commands. Cursor **312** indicates which of icons **311** is selected, with display **307** providing a textual description

or identification.” Although icons **311** represent VCR tapes that can have actions performed on them from the PDA host, it is understood that the icons could be representations of the features of any of the other devices that Harris shows in Fig. 3 can be used in his invention.

**Re Claim 18,**

Harris discloses that the peer devices compare the needs of one device with the capabilities of the other (Fig. 6, blocks **82** and **84**). Figs 8-9 show that the needs of one device can be audio and/or video capability from the other device.

**Re Claim 19,**

Harris discloses that the peer devices compare the needs of one device with the capabilities of the other (Fig. 6, blocks **82** and **84**). Figs 8-9 show that the needs of one device can be audio and/or video capability from the other device.

**Re Claim 20,**

Figs. 8-9 show that one device can need personal information, such as the owner's name, security settings, or a financial transaction, from the other device.

**Re Claims 21 and 27,**

Harris discloses the information that is transmitted to the item including a state of the application program (Blocks **110** and **112** of Fig. 10 disclose uploading the application program to one of the peer devices, and then executing it once it has uploaded. In order for Harris' system to progress from block **110** to **112**, the peer receiving the program must know that the program has completely uploaded, which

constitutes transmitting a state of the program, else the Control Appliance process 102 would not function.).

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is included in the Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. HYLINSKI whose telephone number is (571)270-1995. The examiner can normally be reached on M-Thurs. 7:00a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

